

REMARKS

Claims 1-30 are pending in the present application. Claims 1, 2, 4-7, 12-15, 17-20 and 23-28 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. Claim Objection

The Examiner objected to Claims 23-24 as depending on Claim 14 whereas "the updating means" is in Claim 20. In response, Applicants have amended such claims to depend upon Claim 20.

The Examiner objected to Claims 2, 15 and 28, saying "a" should be "an". In response, Applicants have amended such claims accordingly.

Therefore, the objection of Claims 2, 15, 23-24 and 28 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-30 under 35 U.S.C. § 103 as being unpatentable over US Patent 5,613,154 to Burke et al. This rejection is respectfully traversed.

Generally speaking, the present invention is directed to an improved method, system and program product for moving a data storage unit from one automated data storage system to another. The cited Burke reference does not teach or suggest movement of data storage unit(s) between automated data storage systems.

Specifically with respect to Claim 1, Applicants show that the cited reference does not teach or suggest first and second automated data storage systems, or the claimed step of automatically transporting a copied second data storage unit to a second automated data storage system. Rather, the cited Burke reference teaches a single storage library as shown at 16a in Burke Figure 3. Claim 1 has been amended to further clarify this distinction, which advantageously enables improved handling of data storage units in a secured environment as described at Applicants' Specification at page 16, lines 1-20. Thus, it is shown that amended Claim 1 is not obvious in view of the cited reference.

Nor is there any suggestion of any desire to modify the teachings of the cited reference in accordance with the claimed invention. The fact that a prior art device could

be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The teachings of the cited reference are directed to processing of transient data storage mediums (TDSMs) which are stated by Burke to be storage devices that are stored outside of a library due automated storage library space being limited and expensive (Col. 2, lines 25-54). These TDSM cartridges are manually loaded into the library by an operator (Col. 7, lines 58-60; Col. 9, lines 23-24 and 51-53). Thus, there is no suggestion for automated transfer of such TDSMs between automated storage systems, as these are stored on storage shelves outside of the library (Col. 2, lines 26-28) and manually loaded into the library. Claim 1 is thus further shown to not be obvious in view of the cited reference, as there is no suggestion of any desire to modify the teachings of Burke in accordance with the claimed invention.

Applicants initially traverse the rejection of Claims 2-13 for reasons given above regarding Claim 1 (of which Claims 2-13 ultimately depend upon).

Further with respect to Claim 6, such claim has been amended herewith and Applicants show that the cited reference does not teach or suggest the claimed feature of wherein the first automated data storage system is an unclassified data storage system and wherein the destination data storage system is a classified data storage system that complies with a government security classification. This claimed feature advantageously enables improved handling of data storage units in a secured environment, as described at Applicants' Specification at page 16, lines 1-20.

Further with respect to Claim 10, Applicants show that the cited reference does not teach or suggest "decataloging the second data storage unit from the first automated data storage system". Burke teaches a system for the temporary input/output of TDSMs. As part of the input of a TDSM, the volume label is intentionally ignored since the TDSM will not reside in a library bin (Col. 10, lines 46-49), and thus there is no need for cataloguing of the cartridge and hence no need to decatalogue the cartridge. Thus, Claim 10 is shown to not be obvious in view of the cited reference.

In rejecting Claim 10, the Examiner acknowledges that the cited reference fails to teach decataloging, but asserts that decataloging was 'well known'. Applicants show that

whether or not something is 'well known' is not the proper test for determining obviousness. "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). The Examiner has provided no reason or other motivation of why it would have been obvious to include cataloging in the teachings of Burke. In fact, as shown above, Applicants have shown why there would have been no motivation to include decataloging as it is not required when temporarily processing TDSM cartridges. Thus, Claim 10 is still further shown to have been erroneously rejected as the 'well known' assertion is shown to not meet the obviousness determination requirements as established by the Federal Circuit.

Further with respect to Claim 12 (and similarly for Claim 13), such claim has been amended herewith and Applicants show that the cited reference does not teach or suggest the claimed feature of "a pass-thru port that interconnects the first automated data storage system with the second automated data storage system", which advantageously facilitates automated data storage unit transport between the two automated data storage

systems. In contrast, the cited reference teaches an input/output window for use by an operator to manually load/remove cartridges therefrom, as described above. Thus, Claim 12 (and Claim 13) is further shown to not be obvious in view of the cited reference.

Applicants traverse the rejection of Claim 14 (and dependent Claims 15-26) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 19 for further reasons given above regarding Claim 6.

Applicants further traverse the rejection of Claim 23 for further reasons given above regarding Claim 10.

Applicants further traverse the rejection of Claims 25 and 26 for further reasons given above regarding Claim 12.

Applicants traverse the rejection of Claim 27 (and dependent Claims 28 and 29) for similar reasons to those given above regarding Claim 1.

With respect to Claim 30, Applicants show that the cited reference does not teach or suggest the claimed feature of "a transportation device that transports the data storage unit from the first data storage device to the second data storage device, wherein the transportation device protects against transporting the data storage unit from the second data storage device back to the first data storage device". In rejecting Claim 30, the Examiner cites Burke column 9, line 20 – column 10, line 12; column 7, lines 35-67; and column 8, line 38 – column 9, line 15. Applicants show that the passage cited beginning at column 9 describes an ability for an operator to manually load and unload cartridges into a library, but provides no protection against transporting the data storage unit from the second data storage device back to the first data storage device. The passage cited beginning at column 7 similar describes an ability for an operator to manually load and unload cartridges into a library. There is no teaching or suggestion of any type protection against transporting the data storage unit from the second data storage device back to the first data storage device, as claimed. The passage cited beginning at column 8 describes operation of the library manager controller, including control of a transport assembly to move a gripper. There is no teaching or suggestion of any type protection against transporting the data storage unit from the second data storage device back to the first data storage device, as claimed. Thus, Claim 30 is shown to not be obvious in view of

the cited reference as a prima facie case of obviousness has not been made by the Examiner in rejecting Claim 30. In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants). As shown above, all of the claim limitations are not taught or suggested by the cited reference and thus a prima facie case of obviousness has not been established by the Examiner. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Applicants thus show that the rejection of Claim 30 is improper by the Examiner's failure to establish a prima facie case of obviousness.

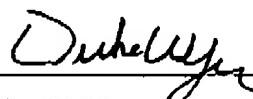
Therefore, the rejection of Claims 1-30 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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